Paper No. 39

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In re Application of                    :
Luc Montagnier et al                    :
Application No. 08/067,148              :       DECISION ON PETITION
Filed: May 26, 1993                     :              AND
Attorney Docket No. 3495.000404        :       NOTICE OF ABANDONMENT


This is a decision on petition filed June 3, 1998, under 37 CFR
1.182 requesting withdrawal of the terminal disclaimer filed May
12, 1994, recorded against U.S. Patent No. 5,217,861.

The petition is dismissed.

Any request for reconsideration of this decision must be
submitted within TWO (2) MONTHS from the mail date of this
decision.  Extensions of time under 37 CFR 1.136(a) are
permitted.  The reconsideration request should include a cover
letter entitled "Renewed Petition under 37 CFR 1.182 and (as
explained below) under both 37 CFR 1.137(b) and 37 CFR 1.183."

*With respect to the petition under 37 CFR 1.182:*

Petitioner asserts that amendments to the claims by way of the
ensuing prosecution, subsequent to the submission of the
aforementioned Terminal Disclaimer, have obviated the need and
reasons for its continued acceptance by the PTO.

Inspection of the record reveals that the PTO acceptance and
recordation of the above-mentioned Terminal Disclaimer, as
indicated in the Office action of July 12, 1994 (at 2), overcame
a rejection of herein claims 15-21 and 32-36, over claims 4,7,
and 9-11 of U.S. patent No. 5,217,861.  Further in this regard, a
review of the amendments filed to date herein reveals that claims
15-21 and 32-36 have now been canceled.

However, petitioner does not aver, and should do so (if in fact
such is an appropriate averment) for any renewed petition, that

the subject matter of the remaining claims does not raise the
question of obviousness- or nonviousness- type double patenting
over U.S. Patent No. 5,217,861.  Absent such an averment, the
petition under 37 CFR 1.182 will not be reconsidered.  It is
brought to petitioner's attention that it is long-established
Office policy to maintain the line of demarcation between
petitionable and appealable subject matter.  MPEP § 1201.
Rather, it is well settled that the Commissioner will not, on
petition, usurp the functions or impinge upon the jurisdiction of
the Board.  See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39,
43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc.,
170 USPQ 43, 44 (Comm'r Pat. 1971).  That is, the PTO will not,
directly or indirectly, while addressing a petitionable issue,
make a finding or certification regarding the absence of
obviousness- or nonviousness- type double patenting over U.S.
Patent No. 5,217,861 as to any claim herein.

As this application is also regarded as abandoned for the reasons
*infra*, any renewed petition under 37 CFR 1.182 will also have to
be accompanied by a petition seeking revival, such that this
application may be returned to the jurisdiction of the examiner.

*With respect to the abandoned status of this application:*

Petitioner should note that this application became abandoned for
applicants' failure to complete, within the meaning of 37 CFR
1.192(a), the Notice of Appeal of January 12, 1995, which
required applicants to file a Brief and fee within two (2)
months, or the appeal would stand dismissed.  As extensions of
time totaling four (4) months were obtained, and no Brief on
Appeal was filed, the appeal of the final rejection of all claims
was dismissed by operation of 37 CFR 1.192(b) on July 12, 1995.
As there were no allowed claims, this application also became
abandoned on the same date.  See Ex Parte Vossen, 155 USPQ 109,
111 (BPAI 1967); MPEP  1215.04.  As such, the date of Abandonment
is July 13, 1995.

As this application became abandoned by operation of 37 CFR
1.192(b) on July 12, 1995, the examiner had no procedural
authority with respect to this abandoned application on or after
that date.  See Lorenz v. Finkl, 333 F.2d 885, 891 142 USPQ 26,
30 (CCPA 1964).  While it is unfortunate that the examiner in the
Office action *inter alia*, of October 18, 1995, withdrew the
finality of the Office action of July 12, 1994, such action(s) by
the examiner was performed without proper authority, and thus,
had no force and effect.  The examiner's action(s) subsequent to

July 13, 1995, cannot have the effect of saving this application from abandonment, because an examiner has no power to revive an abandoned application. Lorenz, supra.

While applicants did file communications on July 11, 1995, and on July 24, 1995, such communications did not *prima facie* place this application in condition for allowance. See Office action of October 18, 1995. This lack reinforces the conclusion that this application became abandoned July 12, 1995. Id.

Petitioner may wish to present a petition under 37 CFR 1.1.137(b), as well as a petition and demonstration of cause under 37 CFR 1.183 which requests that, under the extraordinary circumstances of this application, the requirement of 37 CFR 1.137(c) for a terminal disclaimer equal to the time period of abandonment, be waived. Under the circumstances of this application, the amendment of June 3, 1998, which was filed in response to the Office action of March 3, 1998, will be accepted as the proposed response to continue prosecution, as a component of the petition to revive under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail:    Assistant Commissioner for Patents
            Box DAC
            Washington, D.C.   20231

By FAX:     (703)308-6919
              Attn: Office of Petitions

By Hand:    One Crystal Park, Suite 520
            2011 Crystal Drive
            Arlington, VA

Telephone inquiries concerning this decision should be directed to Special Projects Examiner Brian Hearn at (703)305-1820.

Abraham Hershkovitz
Director, Office of Petitions
Office of the Deputy Assistant Commissioner
  for Patent Policy and Projects